

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of
Yongcai Wang, et al.

Group Art Unit: 1794
Examiner: Pamela R. Schwartz

INKJET RECORDING ELEMENT

Serial No. 10/021,341
Filed December 12, 2001

Mail Stop APPEAL BRIEF - PATENTS
Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

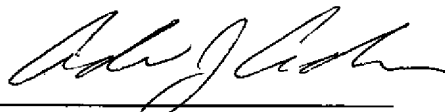
APPELLANTS' SECOND REPLY BRIEF

This Second Reply Brief is in response to the Supplemental
Examiner's Answer mailed August 20, 2009.

Regarding the rejection of claim 17 under 35 USC 112 as being indefinite for failing to point out and distinctly claim the invention, the Examiner notes that titanium dioxide and zinc oxide particles are set forth in a list of suitable inorganic particles in the paragraph bridging pages 4 and 5 of the specification, and since both such particles are well-known UV absorbers, it cannot be determined if claim 17 would include or exclude inorganic particles such as titanium dioxide and zinc oxide that have well-known function as UV absorbers. Such position is not well-taken, as while dependent claim 17 clearly excludes use of UV absorbers that would be effective for preventing light fade in the image receiving layer of the recording element of claim 1, the fact that particles known to have such property may be included in a list of suitable particles for use in a broader context of the invention as covered by the element of claim 1 (which claim is itself distinguished from the prior art on other basis as discussed in Appellants Brief) does not make claim 17 indefinite.

For these reasons, as well as those presented in Appellants' Brief and first Reply Brief, Appellants respectfully submit that the Final Rejection is in error, and request its reversal by the Honorable Board.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Andrew J. Anderson", written over a horizontal line.

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